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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREAS MYKA and CHRISTIAN LINDHOLM

Appeal 2008-3874
Application 10/749,652
Technology Center 2100

Decided:¹ May 13, 2009

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-34, 36-53, 55, and 57-68. Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The invention at issue on appeal relates to bonding 'slave' devices, such as media capture devices, and instruct the devices to communicate captured media files with a specified set of metadata included. (Abstract.)

ILLUSTRATIVE CLAIM

14. A method for wireless bonding of devices and communicating media file transfer parameters, the method comprising:
 - monitoring, at a master device, an area of interest for the presence of potential bondable devices;
 - receiving, at the master device, a presence signal from a potential bondable device;
 - determining bond capability of the potential bondable device;
 - approving the potential bondable device as a bonded device; and
 - communicating, from the master device to the bonded device, media file transfer parameters, including definition of the media file metadata that is to be included with a captured media file.

PRIOR ART

Grosvenor	U.S. Patent Pub. 2003/0021591 A1	Jan. 30, 2003
Burr	U.S. Patent Pub. 2004/0203797 A1	Oct. 14, 2004

REJECTIONS

Claims 14-33 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 14-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Grosvenor.

Claims 1-13, 24-34, 36-53, 55, and 57-68 stand rejected under 35 U.S.C. § 103(a) as being obvious Grosvenor and Burr.

PATENT ELIGIBILITY REJECTION OF CLAIMS 14-33

The Examiner concludes that '[t]he claims are useful and concrete, but they fail to produce a tangible result because no result is stored to non-volatile media or made tangible by, for example, returning a result to a user.' (Answer 4.) The Appellants argue that 'independent Claims 14 and 24 produce a tangible result . . . by communicating information between the master device and the bonded device.' (Appeal Br. 7.)

ISSUE

Therefore, the issue before us is whether claims 14-33 are patent-eligible under § 101.

LAW

'[W]hile looking for 'a useful, concrete and tangible result' may in many instances provide useful indications of whether a claim is drawn to a fundamental principle or a practical application of such a principle, that inquiry is insufficient to determine whether a claim is patent-eligible under § 101.' *In re Bilski*, 545 F.3d 943, 959 (Fed. Cir. 2008). 'A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.' *Id.* at 954 (citing *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)).

FINDINGS OF FACT ('FFs')

1. Independent claim 14 recites the following limitations:

14. A method for wireless bonding of devices and communicating media file transfer parameters, the method comprising:

monitoring, at a master device, an area of interest for the presence of potential bondable devices;

receiving, at the master device, a presence signal from a potential bondable device;

determining bond capability of the potential bondable device;

approving the potential bondable device as a bonded device; and

communicating, from the master device to the bonded device, media file transfer parameters, including definition of the media file metadata that is to be included with a captured media file.

2. Independent claim 24 recites the following limitations:

24. A method for communicating media files and associated media file metadata from a bonded device to a master device, the method comprising:

bonding one or more slave devices to a master device according to predetermined media file transfer parameters communicated to the slave device from the master device; and

communicating a plurality of media files from the one or more bonded devices to the master device, the plurality of media files having metadata information as defined by the predetermined media file transfer parameters.

ANALYSIS

The steps of claims 14 and 24 are performed by a master device or a bondable/bonded slave device. (FF 1-2.) As argued by the Appellants, for example, the independent claims include 'communicating information between the master device and the bonded device.' (Appeal Br. 7.) Therefore, the methods recited in independent claims 14 and 24 are each tied to a particular machine or apparatus.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that claims 14-33 are patent-eligible under § 101.

ANTICIPATION REJECTION OF CLAIMS 14-23

The Examiner finds that in paragraph [0055] of Grosvenor 'an area of interest such as a football match or concert is the location where cameras are 'prepared to accept input', which reads on the claimed monitoring an area of interest' and that 'the master device can be interpreted to be those with the

synchronization information.' (Answer 30.) The Examiner further finds that '[t]he next steps, receiving a presence signal from a potential bondable device and determining bond capability of the device, is found in' paragraph [0056]. (*Id.*) The Appellants argue that 'Grosvenor does not appear to teach 'monitoring' at the first user's camera 20 for a 'presence signal' from a potential bondable device.' (Reply Br. 3.) They further argue that paragraph [0056] 'appears to be unrelated to a 'presence signal.'" (*Id.* at 4.)

ISSUE

Therefore, the issue before us is whether the Appellants have shown error in the Examiner's findings that Grosvenor's first camera monitors an area of interest for the presence of potential bondable devices and receives a presence signal from a potential bondable device.

LAW

'[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim' *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). '[A]bsence from the reference of any claimed element negates anticipation.' *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

FINDINGS OF FACT

3. In Grosvenor '[a] first user, equipped with a digital camera compatible with the method of the present invention, attends an event at which other users of compatible cameras are present.' (§ [0054].) '[T]he first user's camera is initially in an unsynchronised state (S1). The camera is prepared to accept input to cause it to undergo a synchronisation event, which would result in the camera being synchronised with other compatible cameras present at the event' (§ [0055].)

4. '[T]he first camera user takes action (E1) himself to create an event identification code (an 'Event ID'), in readiness for subsequently synchronising his camera with other cameras in a synchronisation event.' (*Id.* § [0056].)

5. 'In a preferred embodiment of the invention this synchronisation event would be initiated by this first camera itself, although it may alternatively be generated by a third party such as the management of the football stadium or theme park at which the common event is taking place.' (*Id.* § [0055].)

6. Further, Grosvenor includes the following disclosure.

[I]n the preferred embodiment of the invention the synchronisation event comprises the first user's camera 20 generating a synchronisation signal that is transmitted to the cameras 22 of the other users present at the event who intend to share their pictures. The signal includes a synchronisation

code, which contains an address code (e.g. a web address) pertaining to the identity and/or location of the repository database, so that each of the synchronised cameras has knowledge of where the pictures are to be sent for sharing, and also the Event ID by which the photographs can be classified in the database repository.

(*Id.* ¶ [0059].)

ANALYSIS

As aforementioned, the Examiner reads the claimed 'master device' on Grosvenor's first camera and the claimed 'monitoring, at a master device, an area of interest for the presence of potential bondable devices' on the first camera's being prepared to accept input to cause it to undergo a synchronization event. As best we can tell, the Examiner reads the claimed 'potential bondable device(s)' on the other compatible cameras present at the event. (FF 3.)

In a preferred embodiment of Grosvenor's invention, the first camera initiates the synchronization event itself (FF 5) by generating a synchronization signal that is transmitted to the cameras of the other users at the event who intend to share their pictures (FFs 4, 6). In an alternative embodiment, a third party such as the management of the football stadium or theme park at which the event is taking place may generate the synchronization event. (FF 5.) We agree with the Appellants that both of these initiations are 'different from 'monitoring an area of interest for the presence of potential bondable devices.'" (Reply Br. 4.) More specifically,

the first camera does not monitor for the presence of other cameras in either embodiment.

As also aforementioned, the Examiner reads the claimed 'receiving, at the master device, a presence signal from a potential bondable device' on the first camera's creation of an Event ID in paragraph [0056] of *Grosvenor*. We agree with the Appellants that the passage from *Grosvenor* appears to be unrelated to a 'presence signal.' The 'Event ID' of *Grosvenor* is simply an identifier that is created by the 'first user' whose camera will be synchronized with other cameras that may or may not be identified at the time the Event ID is created. (Reply Br. 4.) The Event ID is not received from another camera; not does it indicate the presence of another camera.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown error in the Examiner's findings that *Grosvenor*'s first camera monitors an area of interest for the presence of potential bondable devices and receives a presence signal from a potential bondable device.

OBVIOUSNESS REJECTION OF CLAIMS 1-13

When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.

Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

37 C.F.R. § 41.37(c)(1)(vii).

Here, the Appellants argue claims 1-13 as a group. (Appeal Br. 10.) All these claims are subject to the same ground of rejection. We select claim 1 as the sole claim on which to decide the appeal of the group.

ISSUE

The Examiner finds that Grosvenor

teaches . . . a media transfer application code that is executed by the data processor for providing media file transfer parameters, the parameters including instructions to communicate captured media files with a specified set of metadata included in the communication; (synchronize and transfer photographs with time taken to repository, paragraph [0067])

(Answer 8-9.) The Appellants argue that 'paragraph 0067 indicates that the digital camera simply provides pictures and associated metadata, and not instructions regarding the provision of pictures and metadata.' (Reply Br. 5.) Therefore, the issue before us is whether the Appellants have shown error in the Examiner's finding that teachings of Grosvenor, complemented by the knowledge of persons skilled in the art, would have suggested instructions regarding the provision of pictures and metadata.

LAW

The question of obviousness is 'based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently.' *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)). "Every patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed" *In re Bode*, 550 F.2d 656, 660 (CCPA 1977) (quoting *In re Wiggins*, 488 F.2d 538, 543 (CCPA 1973)). Those persons 'must be presumed to know something' about the art 'apart from what the references disclose.' *In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962).

"A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

FINDINGS OF FACT

7. Each of Grosvenor's cameras is 'designed to make use of any available opportunity to make the pictures that it currently holds available for sharing by the other users via the repository, using a digital communication connection.' (§ [0072].) Further, Grosvenor includes the following disclosure.

On establishing a suitable data communication connection . . . the camera automatically identifies the repository using the address specified in the synchronisation code and enters (E4, FIG. 1) a download state (S4). Photographs that have not been designated as not to be shared (i.e. photographs the user has tacitly consented to be included in the repository) are then automatically made available to the repository, with no user intervention necessary.

(*Id.* ¶ [0075].)

8. '[I]t is advantageous for the digital camera to assign a reference code to each of the photographs that has been taken. This code is transmitted with the photograph to the repository.' (*Id.* ¶ [0067].)

ANALYSIS

Grosvenor's first camera automatically downloads photographs to the repository without user intervention. (FF 7.) The downloading includes transmitting a reference code for each photograph. (FF 8.) We agree with the Examiner that the reference codes constitute metadata. The process of automatically downloading photographs and metadata to the repository at any available opportunity (FF 7), moreover, evidences that the first camera is programmed with instructions regarding the provision of pictures and metadata.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown no error in the Examiner's finding that teachings of Grosvenor, complemented by the knowledge of persons skilled in the art,

would have suggested instructions regarding the provision of pictures and metadata.

OBVIOUSNESS REJECTION OF CLAIMS 24-33

The Examiner finds that Grosvenor teaches 'communicating a plurality of media files from the one or more bonded devices to the master device, (synchronize and transfer photographs with time taken to repository, paragraph [0067]).' (Answer 13.) The Appellants argue that 'paragraph 0067 does not teach 'communicating a plurality of media files from the one or more bonded devices to the master device.'" (Reply Br. 6.)

ISSUE

Therefore, the issue before us is whether the Appellants have shown error in the Examiner's finding that Grosvenor teaches that one or more bonded devices communicates media files to the reference's first camera.

ANALYSIS

We agree with the Appellants that the master device of claims 24 and 31 'must . . . receive media files from the slave devices.' (Reply Br. 6.) As aforementioned, the Examiner reads the claimed 'master device' on Grosvenor's first camera. As best we can tell, he reads the claimed 'bonded devices' on the other compatible cameras present at the event. (FF 3.) Grosvenor's other cameras, however, download photographs to the repository (FF 7), not to the first camera.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown error in the Examiner's finding that Grosvenor teaches that one or more bonded devices communicates media files the reference's first camera.

OBVIOUSNESS REJECTION OF CLAIMS 34, 36-53, 55, AND 57-68

Here, the Appellants argue claims 34 and 36-51 as a group (Reply Br. 7-8) and claims 52, 53, 55, and 57-68 as another group (Appeal Br. 11-12.) All these claims are subject to the same ground of rejection. We select claims 34 and 52 as the sole claims on which to decide the appeal of the respective groups.

ISSUE

The Examiner finds that Grosvenor teaches 'computer-readable program instructions comprising a media transfer application code that provides media file transfer parameters that include instructions for creation of media file metadata information; (synchronize and transfer photographs with time taken to repository with picture and time taken stored as reference code, paragraph [0067]).' (Answer 17.) The Appellants argue that 'neither the digital cameras nor the repository discussed in that passage have the capability to provide 'instructions comprising a media file collection application code for communicating the collection of media files to one or more devices.' (Reply Br. 7.) They also argue that 'Grosvenor does not describe compiling a plurality of media files at a device and communicating

the compilation of media files to another device based on sharing information parameters.' (Appeal Br. 11.) Therefore, the issue before us is whether the Appellants have shown error in the finding that teachings of Grosvenor, complemented by the knowledge of persons skilled in the art, would have suggested combining media files at a device and communicating the combination of files to another device based on sharing parameters and instructions for communicating a collection of media files to one or more devices.

FINDINGS OF FACT

9. Grosvenor's 'repository is a medium through which the photographs taken by the users' synchronised cameras can be accessed and shared.' (§ [0072].)

10. The repository uses the aforementioned reference code (FF 8) including the time of taking a photograph and camera-specific information 'to catalogue the pictures taken at the common event, and also to allow users, on accessing the repository, to view the pictures taken in chronological sequence irrespective of the photographer, or in terms of the identity of the photographer, or in a sequence dependent on both these parameters.' (*Id.* § [0067].)

11. Further, Grosvenor includes the following disclosure.

Admittance to the repository, to access pictures taken at a specific common event, is preferably restricted by the repository, requiring the user to supply an user ID (which may be the Event ID)

and password. Admittance is primarily intended for those whose cameras were synchronised at the event, who are given the user ID (or the Event ID) and password

(*Id.* ¶ [0082].)

12. Additionally, Grosvenor includes the following disclosure.

[T]he repository is provided by a fileserver

. . . .

[T]he fileserver can comprise the data storage media of one or more PCs [i.e., personal computers] 70 connected to a data communication network such as the Internet 52, in an analogous fashion to the 'Napster' system for the sharing of music files. The photographs are first downloaded onto the PCs from the digital cameras 82, and then the photographs are made available for sharing.

(*Id.* ¶¶ [0072]-[0074].)

ANALYSIS

Grosvenor's repository catalogues pictures taken at a common event. (FF 10.) Therefore, we agree with the Examiner's finding that Grosvenor combines media files at a device, viz., its repository. Once catalogued, the repository allows users of the other cameras to view the pictures stored therein. (FF 9-10.) Because access is restricted based on a user ID (which may be the Event ID) and a password (FF 11), we find that Grosvenor's repository communicates the combination of files to another device (i.e., camera) based on sharing information parameters.

The repository may comprise the data storage media of at least one PC (FF 10.) The operation of allowing sharing of photos (FF 9-10) evidences that the PC-based repository is programmed with instructions for communicating a collection of media files to one or more devices.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown no error in the Examiner's finding that teachings of Grosvenor, complemented by the knowledge of persons skilled in the art, would have suggested combining media files at a device and communicating the combination of files to another device based on sharing parameters and instructions for communicating a collection of media files to one or more devices.

DECISION

We reverse the rejections of claims 14-33 under 35 U.S.C. § 101, of claims 14-23 under 35 U.S.C. § 102(e), and of claims 24-33 under 35 U.S.C. § 103(a). In contrast, we affirm the rejection of claims 1-13, 34, 36-53, 55, and 57-68 under 35 U.S.C. § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Appeal 2008-3874
Application 10/749,652

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